

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY P. GRANGER

Appeal No. 96-4045
Application 08/441,984¹

ON BRIEF

Before Calvert, Abrams and Pate, *Administrative Patent Judges*.

Pate, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
4 through 6 and 21 through 23. These are the only claims

¹ Application for patent filed May 16, 1995. According to appellant, this application is a continuation of Application 08/115,516, filed September 1, 1993 (Abandoned).

remaining in the application.

The claimed invention is directed to a stamped door lock bracket for an automobile or the like. The bracket is comprised of a flange portion which is attached to the door frame with screws, a generally perpendicularly extending base portion, and an aperture portion with an aperture therein to interact with the door latch bolt.

Claim 22, reproduced below, is further illustrative of the claimed subject matter.

22. A one piece stamped door lock bracket comprising:

a unitary planar bank form defining a base portion having one end and an opposite end; a flange portion complementary with said one end of said base portion; and an apertured portion having one end integral with said opposite end of said base portion and an opposite end extending in a direction away from said base portion;

means for deforming said one end of said apertured portion with respect to said base portion such that said opposite end of said apertured portion is substantially perpendicular to said base portion and flange portion, said deforming means further deforming said base portion with respect to said flange portion such that said apertured portion is substantially perpendicular to said flange portion; and

means for securing said opposite end of said apertured

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portion to said flange portion.

The reference of record relied upon by the examiner as evidence of anticipation under 35 U.S.C. § 102(b) is:

Peterson et al. (Peterson)	4,998,759	Mar. 12, 1991
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The following rejections are before us on appeal. Claim 22 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the examiner, lines 7 through 12 are not drawn to the structural characteristics of the bracket but are drawn to some structure that is separate from and manipulates the bracket.

Claims 4 through 6 and 21 through 23 have been rejected under 35 U.S.C. § 102(b) as anticipated by Peterson. According to the examiner, Peterson discloses a bracket formed from a unitary planar blank with a base 24, a flange 26, and an aperture portion 30, 34, 36, 38 having one end integral with the opposite end of the base portion 24. Reference is

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made to the examiner's answer, page 4 for the further details of this 35 U.S.C. § 102(b) rejection.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the conclusion that claim 22 is indefinite under the purview of 35 U.S.C. § 112, second para-graph. Therefore, the rejection of this claim will be affirmed. However, with respect to claims 4 through 6 and 21 through 23, it is our view that these claims are so indefinite as to preclude the possibility of properly construing them for an art rejection. Therefore, as outlined below, pursuant to our authority under 37 CFR § 1.196(b), we will enter a rejection of these claims under § 112, second paragraph, and reverse the rejection thereof under 35 U.S.C. § 102(b).

Turning to the rejection of claim 22 under 35 U.S.C. § 112, second paragraph, we note that

[t]he use of the term 'means' has come to

be so closely associated with 'means-plus-function' claiming that it is fair to say that the use of the term 'means' (particularly as used in the phrase 'means for') generally evokes § 112(6) and that the use of a different formulation generally does not. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584, 39 USPQ2d 1783, 1787 (Fed. Cir. 1996).

Since the language of claim 22, lines 7 through 12 evokes § 112(6), and since § 112(6) requires us to construe claim limitations in light of the structure, material, or acts in support thereof in the specification and the equivalents thereof, *In re Donaldson & Co.*, 16 F.3d 1189, 1193, 29 USPQ 1845, 1848 (Fed. Cir. 1994), we must look to appellant's specification for proper construction of the "means for deforming" in line 6 of claim 22. The following passages from appellant's specification are examples of passages that indicate that the claimed door lock bracket is deformed in a separate bending apparatus: page 3, lines 22-24; page 4, lines 20-23 and lines 26-32, page 5, line 18; page 6, line 30; page 7, lines 4-10; page 8, lines 7-10 and lines 18-20. Therefore, it is quite

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clear that the "means for deforming" limitation of claim 22 when construed in light of the specification can only refer to a separate apparatus for performing the bending operation and not a bend or deformation in the planar U-shaped blank itself. The examiner is quite correct in stating that the "means for deforming" literally refers to an apparatus for performing the deforming operation. The rejection of claim 22 under 35 U.S.C. § 112, second paragraph, is affirmed. Pursuant to 37 CFR § 1.196(b) we make the following new rejection. Claims 4 through 6, and 21 through 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

In the two independent claims on appeal, we note that the claim preamble refers to an article, namely, a one-piece stamped door lock bracket. However, we further note that the first paragraph of the independent claims recites a "unitary planar blank form" which is an intermediate article and is not present in the finished door lock bracket article. The second

paragraph of claim 23 refers to deformed portions which are not present in the unitary planar blank form. Thus, the independent claims on appeal are patently ambiguous as to whether an intermediate planar blank form is being claimed or a finished article -- a door lock bracket -- which is not a planar form is being claimed. In view of this situation, it is our opinion that no definite meaning can be ascribed to the claim limitation of a "unitary planar blank form" when read in conjunction with the preamble and the second paragraph of claim 22 or the second and third paragraphs of claim 23. When this is true of the terms in a claim, the subject matter of the claim cannot be held to be anticipated, but rather the claim becomes indefinite. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since the rejection under 35 U.S.C. § 102 cannot be based on speculation and assumptions, we are constrained to reverse the examiner's rejection of claims 22 and 23 and claims 4, 6, and 21 which depend from claim 23.

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See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). It should be understood however, that a reversal of the rejection under § 102 is not a reversal on the merits of the rejection, but rather a procedural reversal predicated upon the indefiniteness of the claimed subject matter.

SUMMARY

The rejection of claim 22 under 35 U.S.C. § 112, second paragraph, has been affirmed.

A rejection of claims 4 through 6 and 21 through 25 pursuant to 37 CFR § 1.196(b) under 35 U.S.C. § 112, second paragraph, has been entered by the Board.

The rejection of claims 4 through 6 and 21 through 23 under 35 U.S.C. § 102(b) has been reversed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197

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(Oct. 10, 1997),

1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART
37 CFR § 1.196(b)

	Ian A. Calvert)	
	Administrative Patent Judge)	
)	
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	Neal E. Abrams)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
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